

04-18-03

PTO/SB/29 (10-00)

Approved for use through 10/31/2002. OMB 0651-0032

U.S. Patent and Trademark Office; U.S. DEPARTMENT OF COMMERCE

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CONTINUED PROSECUTION APPLICATION (CPA) REQUEST TRANSMITTAL

Submit an original, and a duplicate for fee processing.

(Only for Continuation or Divisional applications under 37 CFR 1.53(d))

CHECK BOX, if applicable:

☐ DUPLICATE

Address to:

Assistant Commissioner for Patents
Box CPA
Washington, DC 20231

Attorney Docket No.
of Prior Application

1128.006

First Named Inventor

R. L. L. L. L.

Examiner Name

Stodola

Group Art Unit

3634

Express Mail Label No.

This is a request for a ☐ continuation or ☐ divisional application under 37 CFR 1.53(d),
(continued prosecution application (CPA)) of prior application number 09 / 376,461,
filed on 8/18/99, entitled Stylight Flashing.

NOTES

FILING QUALIFICATIONS: The prior application identified above must be a nonprovisional application that is either: (1) complete as defined by 37 CFR 1.51(b), or (2) the national stage of an international application in compliance with 35 U.S.C. 371. Effective May 29, 2000, a CPA may only be filed in a utility or a plant application if the prior nonprovisional application was filed before May 29, 2000. A CPA may be filed in a design application regardless of the filing date of the prior application. See "Request for Continued Examination Practice changes to and Provisional Application Practice," Final Rule, 65 Fed. Reg. 50092 (Aug. 16, 2000); Interim Rule, 65 Fed. Reg. 14865 (Mar. 20, 2000), 1233 Off. Gaz. Pat. Office (Apr. 11, 2000).

C-I-P NOT PERMITTED: A continuation-in-part application cannot be filed as a CPA under 37 CFR 1.53(d), but must be filed under 37 CFR 1.53(b).

EXPRESS ABANDONMENT OF PRIOR APPLICATION: The filing of this CPA is a request to expressly abandon the prior application as of the filing date of the request for a CPA. 37 CFR 1.53(b) must be used to file a continuation, divisional, or continuation-in-part of an application that is not to be abandoned.

ACCESS TO PRIOR APPLICATION: The filing of this CPA will be construed to include a waiver of confidentiality by the applicant under 35 U.S.C. 122 to the extent that any member of the public who is entitled under the provisions of 37 CFR 1.14 to access to, copies of, or information concerning, the prior application may be given similar access to, copies of, or similar information concerning, the other application or applications in the file jacket.

35 U.S.C. 120 STATEMENT: In a CPA, no reference to the prior application is needed in the first sentence of the specification and none should be submitted. If a sentence referencing the prior application is submitted, it will not be entered. A request for a CPA is the specific reference required by 35 U.S.C. 120 and to every application assigned the application number identified in such request, 37 CFR 1.78(a).

WARNING: Information on this form may become public. Credit card information should not be included on this form. Provide credit card information and authorization on PTO-2038.

- ☐ Enter the unentered amendment previously filed on _____ under 37 CFR 1.116 in the prior nonprovisional application.
- ☒ A preliminary amendment is enclosed.
- This application is filed by fewer than all the inventors named in the prior application, 37 CFR 1.53(d)(4).
 - ☐ **DELETE** the following inventor(s) named in the prior nonprovisional application:
.....
 - ☐ The inventor(s) to be deleted are set forth on a separate sheet attached hereto.
- ☐ A new power of attorney or authorization of agent (PTO/SB/81) is enclosed.
- Information Disclosure Statement (IDS) is enclosed:
 - ☐ PTO-1449
 - ☐ Copies of IDS Citations

APR 22 2003

GROUP 3600

[Page 1 of 2]

Burden Hour Statement: This form is estimated to take 0.4 hours to complete. Time will vary depending upon the needs of the individual case. Any comments on the amount of time you are required to complete this form should be sent to the Chief Information Officer, U.S. Patent and Trademark Office, Washington, DC 20231. DO NOT SEND FEES OR COMPLETED FORMS TO THIS ADDRESS. SEND TO: Assistant Commissioner for Patents, Box CPA, Washington, DC 20231.

04/21/2003 RHEBRANT 00000001 09376461

375.00 OP
42.00 OP01 FC:2006
02 FC:220104/21/2003 RHEBRANT 00000001 09376461
342.00 OP
02 FC:2808

CLAIMS	(1) FOR	(2) NUMBER FILED	(3) NUMBER EXTRA	(4) RATE	(5) CALCULATIONS
TOTAL CLAIMS (37 CFR 1.16(c) or (j))		15 -20* =	0	x \$ _____ =	\$ 0
INDEPENDENT CLAIMS (37 CFR 1.16(b) or (i))		4 -3** =	1	x \$ 42 =	42
MULTIPLE DEPENDENT CLAIMS (if applicable) (37 CFR 1.16(d))				+ \$ _____ =	0
				BASIC FEE (37 CFR 1.16)	375
				Total of above Calculations =	\$417
Reduction by 50% for filing by small entity (Note 37 CFR 1.27).					
* Reissue claims in excess of 20 and over original patent. ** Reissue independent claims over original patent.					
TOTAL =					\$417

6. ☒ Small entity status: Applicant claims small entity status. See 37 CFR 1.27.
7. The Commissioner is hereby authorized to credit overpayments or charge the following fees to Deposit Account No. _____:
- a. ☐ Fees required under 37 CFR 1.16.
- b. ☐ Fees required under 37 CFR 1.17.
- c. ☐ Fees required under 37 CFR 1.18.
8. ☒ A check in the amount of \$ 417 is enclosed.
9. ☐ Payment by credit card. Form PTO-2038 is attached.
10. ☐ Applicant requests suspension of action under 37 CFR 1.103(b) for a period of _____ months (not to exceed 3 months) and the fee under 37 CFR 1.17(i) is enclosed.
11. ☐ New Attorney Docket Number, if desired _____
[Prior application Attorney Docket Number will carryover to this CPA unless a new Attorney Docket Number has been provided herein.]
12. a. ☐ Receipt For Facsimile Transmitted CPA (PTO/SB/29A)
- b. ☒ Return Receipt Postcard (Should be specifically itemized, See MPEP 503)
13. ☐ Other: _____

NOTE:

The prior application's correspondence address will carry over to this CPA
UNLESS a new correspondence address is provided below.

14. NEW CORRESPONDENCE ADDRESS
☐ Customer Number or Bar Code Label

or ☐ New correspondence address below

(Insert Customer No. or Attach bar code label here)

Name

Address

City

State

Zip Code

Country

Telephone

Fax

15. SIGNATURE OF APPLICANT, ATTORNEY, OR AGENT REQUIRED

Name (Print /Type)

Signature

Registration No. (Attorney/Agent)

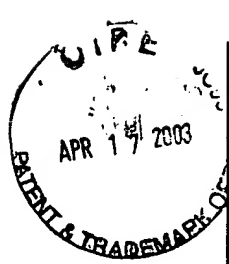
Date

John L. Rogitz

[Signature]

33,549

4/2/03



151C
M.P.
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IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

First Named Applicant: Rillie)	Art Unit: 3634
)	
Serial No.: 09/376,461)	Examiner: Stodola
)	
Filed: August 18, 1999)	1128.006A
)	
For: SKYLIGHT FLASHING)	April 11, 2003
)	750 B STREET, Suite 3120
)	San Diego, CA 92101
)	

RESPONSE TO OFFICE ACTION - CONTINUED PROSECUTION APPLICATION (CPA)

Commissioner of Patents and Trademarks
Washington, DC 20231

RECEIVED

APR 22 2003

Dear Sir:

GROUP 3600

Please amend the specification by inserting the priority claim contained in the clean and marked-up versions of page 1, and please replace the original declaration with the enclosed substitute declaration.

This CPA is filed in response to the Office Action dated March 28, 2003. The telephonic interview granted on April 11, 2003 is gratefully acknowledged.

The Office Action rejects all pending claims for obviousness based on Chao et al. combined with various other references uncovered pursuant to a post-decision search. Since this application now claims priority from U.S. Pat. No. 6,035,593, which discloses the same subject matter being relied on in Chao et al. to reject the present claims (namely, a frusto-conical metal flashing with a skylight tube below it) and which was filed before Chao et al. issued, Chao et al. is no longer prior art by virtue of 35 U.S.C. §102(a), leaving Chao et al. prior art only by virtue of 35 U.S.C. §102(e). Moreover, at the time the present

No interview.
Appl. merely
complained about
rejs. after Board
decision.
DPS
5/12/03

invention was made, the application and Chao et al. were owned by the same entity and/or subject to assignment to the same entity, namely, Solatube International. Accordingly, Chao et al. is disqualified as Section 103 prior art.

Additionally, as the enclosed Rule 132 declaration attests, the present invention was reduced to practice and/or conceived before Chao et al. issued, further removing Chao et al. as Section 102(a) prior art.

Moreover, the following comments apply to the proposed combinations of references. With respect to Nagler et al., nowhere does Nagler et al. mention the word "skylight", much less mention that it can be used with skylights. Nagler et al. is directed to roof-mounted pipes. The general motivations relied on in the rejection are thus just that - general, directionless motivations that fail to suggest the specific application of the present claims. Chao et al. nowhere suggests that one could look to the roof-mounted pipe art, nor has any evidence of record been adduced that one skilled in the skylight art would know to look in the roof-mounted pipe art for ideas. A prior art showing that the roof-mounted pipe art is logically looked to by skylight artisans (as otherwise required by MPEP §2141.01(a)) is hereby seasonably requested under MPEP §2144.03, should the examiner persist in the use of Nagler et al.

With respect to Deutsch, nowhere does this reference motivate or suggest use of its flashing with anything other than a roof aperture. How it might be combined with a skylight tube assembly is a mystery, rendering the success of the proposed combination with Chao et al. uncertain and hence an unreasonable expectation in contravention of MPEP §2141.

With respect to Clarke et al., a reference, oddly, directed to sewage manhole covers, Applicant disputes that sewer manhole covers are analogous to skylights in that no evidence has been adduced that the

skilled skylight artisan would logically look to the manhole cover art as would otherwise be required by MPEP §2141.01(a).

The specification has been objected to for the boilerplate language on page 8. It is noted that Group 3600 has issued the following patents, all of which contain the objected-to language verbatim: 6,321,493, 6,363,668, 6,412,238, and 6,415,563, to name but a few. Also enclosed is a page from a decision on petition in another application responding to a similar objection to the exact language being objected to here.

Last, as discussed on the telephone, while Applicant understands the examiner's point that Chapter 1200 of the MPEP does not explicitly proscribe a post-appeal search in so many words, for the record MPEP §1214.04 cautions:

"The examiner should *never* regard such a [Board] reversal as a challenge to make a new search to uncover other and better references. *This is particularly so where the application has been transferred to an examiner other than the one who rejected the claims leading to appeal. The second examiner should give full faith and credit to the prior search*" (emphasis mine).

Plainly, the Office's current lenient position regarding post-decision searches is somewhat eroded, to say the least, by any fair reading of the MPEP. In the U.S. constitutional system, where the federal government can exercise only those powers it has been explicitly granted, it is a generally accepted imperative that all permitted agency actions be clearly set forth in written rules and regulations. Deducing an authority to take an action from the silence of the rules to explicitly proscribe that action (particularly when, as here, the relevant agency rules come as close to an explicit prohibition as might be imagined) is contrary to the spirit of our general political philosophy. If post-reversal searches without Board direction

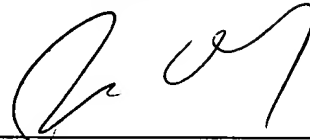
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5/12/03

CASE NO.: 1128.006A
Serial No.: 09/376,461
April 11, 2003
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PATENT
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to undertake them is something the Patent Office wishes to continue to pursue, it is suggested that MPEP Chapter 1200 be amended to give a fair indication to the public.

Respectfully submitted,



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JLR:jg